



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/566,654

02/01/2006

Georges Moineau

284854US0PCT

7532

22850

7590

11/12/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

COONEY, JOHN M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

11/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,654	<b>Applicant(s)</b> MOINEAU ET AL.	
	<b>Examiner</b> John Cooney	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Applicant's arguments filed 7-27-09 have been fully considered but they are not persuasive.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al.(4,264,743), alone, or in view of Peterson et al.(4,386,166).

Maruyama et al. discloses preparations of flexible polyurethane foams prepared by mixing a hydrophobic polyol as claimed, an isocyanate, and blowing agent including water and passing the foam to a location to allow for it to foam, crosslink, and cure to products having densities as claimed and having good permeability and waterproofing properties under compression which are seen to meet the ranges of compression property values defined by applicants' claims (see column 4 line 17 – column 10 line 50, Examples, and claims).

Maruyama et al. differs from applicants' claims in that it does not specifically require NCO Index values as claimed by applicants' claims. However, the reference specifically identifies preferred values for approaching the Index values of applicants' claims and identifies benefits and weaknesses, respectively, associated with operating

Art Unit: 1796

within and beyond the preferred ranges of the instant claims (column 8 lines 24-32). Accordingly, it would have been obvious for one having ordinary skill in the art to have operated at ratios of Index values below the preferred ratios of Maruyama et al.'s disclosure if one were not interested in the good contact angle with water afforded to products having fuller reaction of available hydroxyl groups for the purpose of obtaining acceptable products having residual hydroxyl functionality in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of the same properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)**. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). Additionally, it should be noted that all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. *In re Mills*, 176 USPQ; *In re Lamberti*, 192 USPQ 278; *In re Boe*, 148 USPQ 507.

Although Maruyama et al. discloses manufacture of films in its disclosure, it differs from applicants' claims in that it does not exemplify the casting and laminating the mixtures of its disclosure to films on conveyor belts passing through ovens.

Art Unit: 1796

However, Peterson et al. discloses the making of urethane foam composite articles through the casting and laminating of mixtures to films on conveyor belts passing through ovens (see abstract & column 9 line 39-column 10 line 20). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the composite article forming processes of Peterson et al. in the foam manufacturing processes of Maruyama et al. for the purpose of making acceptable reinforced articles in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' arguments have been considered. However, rejection is maintained. The discrepancies between the Index values of applicants' claims and those of Maruyama et al. are maintained to be properly addressed in the rejection above, and have not been refuted by applicants' reply. Applicants' have not attached criticality to the Index values of their claims. A sufficient showing of new or unexpected results attributable to this difference in the claims that is commensurate in scope with the scope of the claims and demonstrated to be more significant than the expected results of record has not been made and is not seen to be evident.

Difference is not seen between the material make-up of the preparations of applicants' claims and those of Marayuma et al. beyond the differences indicated in the rejection above. It is not seen, nor is it made evident, that difference in applicants' claims based on the compression values of the claims may be attributed to difference in any material feature of the preparations of the claims, including the Index values of the

Art Unit: 1796

claims. Further, even if the compression values were to be associated with the Index values of the claims, these results would necessarily need to be demonstrated to be more significant than the results of record that would be expected from such a change. Based on the evidence of record including physical data that is provided for by Maruyama et al., it is not seen that difference based on the range of compression force values of applicants' claims over what is provided for by the teachings and fair suggestions of Maruyama et al., alone, or in combination with Peterson et al. is evident.

The Office is not in a position to run experiments to verify that the ranges of compression force values possessed by the preparations of Maruyama et al. and/or that would result from making the changes to Index values indicated in the rejection above.

It is held and maintained that that burden is appropriately shifted to applicants.

Applicants' statement that comparative 1 represents Maruyama et al. is not seen to sufficiently meet applicants' burden of showing new or unexpected results attributable to differences in applicants' claims that are commensurate in scope with applicants' claims. First, it is not seen or demonstrated how this comparison represents the teaching of Maruyama et al. Second, even if it were demonstrated to represent an embodiment of Maruyama et al., it is not seen or made evident that this single showing is representative of what is taught or fairly suggested by the full teaching of Maruyama et al. or is sufficient in satisfying the requirement that applicants' showing be commensurate in scope with the scope of applicants' claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/  
Primary Examiner, Art Unit 1796